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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,483	06/02/2000	ANDREAS MELZER	37418/DBP	8000

7590 04/24/2003

D BRUCE PROUT
CHRISTIE PARKER & HALE
P O BOX 7068
PASADENA, CA 91109-7068

EXAMINER

SHAH, DEVAANG

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 04/24/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529,483

Applicant(s)

MELZER ET AL.

Examiner

Devaang Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34, 36, and 37 is/are rejected.
- 7) ☒ Claim(s) 35 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what structural elements and their respective functions are set forth.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 9-15, 19-22, 24-28, 36, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,727,552 to Ryan. Ryan discloses a catheter employing a passive resonance circuit consisting of an LC circuit. The catheter includes a medical device that is capable of being unfolded. The passive resonance circuit is used to locate the catheter (column 2, lines 56-67; column 3, lines 1-6). The catheter location system may be used in a balloon catheter system or any other monitor and/or

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stimulation system (column 6, lines 4-30). The inductor is the form of a coil (column 5, lines 34-67; column 6, lines 1-3; figures 4 and 5). The capacitor is in the form of parallel conductors running along the axis of the catheter (figures 4 and 5, elements 38 and 40). The passive resonance circuit is located using high frequency radiation in an external magnetic field.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan. Ryan discloses a catheter employing a passive resonance circuit, as stated above. Ryan does not explicitly disclose a configuration in which the axis of the inductor is perpendicular to the axis of the device. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to orient the inductor with its axis perpendicular to the longitudinal axis of the device because Applicant has not disclosed that such an orientation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a parallel configuration because all functions Applicant is claiming would be able to be carried out.

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Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-15, 18-26, 31, 32, 34, and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 16, 18, 19, 23-27, and 30-35 of U.S. Patent No. 6,280,385 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the application represent the claims of U.S. Patent No. 6,280,385 B1 in broader scope. It would have been obvious to one having ordinary skill in the art at the time of the invention to broaden the scope of the claims to unfolding a medical device instead of unfolding a stent depending on the medical application of interest. Furthermore, the broader scope of the application is inherently included in the narrower scope of U.S. Patent No. 6,280,385 B1.

Claims 27-30, 33, and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 16, 18, 19, 23-27, and 30-35 of U.S. Patent No. 6,280,385 B1 in view of U.S. Patent No. 5,727,552

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to Ryan. Ryan discloses a catheter employing a passive resonance circuit consisting of an LC circuit. The passive resonance circuit is used to locate the catheter (column 2, lines 56-67; column 3, lines 1-6). The catheter location system may be used in a balloon catheter system or any other monitor and/or stimulation system (column 6, lines 4-30). The inductor is the form of a coil (column 5, lines 34-67; column 6, lines 1-3; figures 4 and 5). The capacitor is in the form of parallel conductors running along the axis of the catheter (figures 4 and 5, elements 38 and 40).

Allowable Subject Matter

5. Claims 35 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devaang Shah whose telephone number is 703-306-0333. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703 308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-308-0758 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DS DS
April 20, 2003

A handwritten signature in black ink, appearing to read 'M. Lateef', with a stylized, flowing script.

Marvin M. Lateef
Supervisory Patent Examiner
Group 3700